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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,956	07/18/2003	Jordan M. Slott	SUN030102	3992

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EXAMINER	
HSU, JONI	

ART UNIT	PAPER NUMBER
2628	

DATE MAILED: 08/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 10/622,956	**Applicant(s)** SLOTT ET AL.	
	Examiner Joni Hsu	**Art Unit** 2628	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 August 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: *see attached sheet*. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *1-13, 47-59, 72*.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

ULKA CHAUHAN
SUPERVISORY PATENT EXAMINER

Applicant argues that the Examiner's previous statement that "A bitmap is the same as a frame buffer or memory" and therefore QuickDraw's use of the bitmap is the same as Applicants' use of off-screen memory is contradicted in Applicants' disclosure and in the text of the Epard reference (US005241625A) (page 15, paragraph 2). The proposed combination of Yang (US 20020035596A1) with Epard still fails to address the fact that Epard discloses the use of QuickDraw 21 and bitmaps and therefore teaches away from such combination. The proposed combination is improper because Epard does not disclose this feature because Epard uses completely different means in a completely different environment (pages 16-17). The Examiner is failing to consider the cited references as a whole, including the recited limitations and working environments and tools used with the references such as the use of QuickDraw 21 and bitmaps. The Examiner has failed to show a suggestion or desirability, and thus the obviousness, of making the proposed combination in either reference. The Examiner has failed to show a reasonable expectation of success. The Examiner is using impermissible hindsight vision afforded by the claimed invention to propose an improper combination (page 18).

In reply, the Examiner disagrees. Yang teaches that the off-screen bitmaps are stored in an off-screen memory with available memory [0017]. Epard and Yang are both directed to remote control of a client's off-screen surface (Col. 11, lines 54-57; Col. 6, lines 40-49; Col. 8, lines 6-10 in Epard; [0017] in Yang), and therefore they are both directed to using similar means in a similar environment. Since Epard teaches the use of off-screen bitmaps (Col. 8, lines 6-10), the device of Epard can be modified by Yang so that the off-screen bitmaps of Epard are stored in an off-screen memory with available memory as taught by Yang because Yang discloses the advantage of reducing the amount of graphical data transmitted between the server and the client,

which increases the performance speed [0004, 0005]. Therefore, Yang discloses that modifying the device of Epard to include this off-screen memory would improve the performance of the device of Epard, and therefore gives motivation to combine Yang and Epard. Epard would be modified by having QuickDraw copy bit images to a bitmap off-screen (Col. 8, lines 6-10 in Epard) within an off-screen memory with available memory, as suggested by Yang, so that images can be displayed more quickly, which is the intended purpose of Epard (Col. 3, lines 5-43 in Epard).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).